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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,754	01/22/2002	Steven B. Dunn	MBI-1085	5503

7590 11/03/2003

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EXAMINER	
PUROL, DAVID M	

ART UNIT	PAPER NUMBER
3634	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/053,754	DUNN ET AL.	
	Examiner	Art Unit	
	David M Purol	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27,30,33-41 and 43-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27,30,33-41 and 43-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,9-18,27,41,43,44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lii '467. Lii '467 discloses the claimed invention including a housing 8, a drum member 1, a shade element 12, a biased retraction and arresting mechanism 2,5,4,3,61,615,71,72,70,7,32,611,31, a first mounting means 82,83.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-8,23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lii '467 in view of McGuire. Lii '467 discloses the claimed invention absent the use of marker elements. McGuire discloses a retractable weblike vehicle apparatus comprising a marker element 27, wherein, to incorporate this teaching into the sunshade of Lii '467 for the purpose of entertainment or aesthetics would have been obvious to one of ordinary skill in the art.

3. Claims 19-22,30,33-40,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lii '467 in view of Park. Lii '467 discloses the claimed invention absent the specific use of suction cups for mounting the sunshade. Park discloses a vehicle sunshade comprising suction cups including a gripping member 5,4,2, wherein,

to incorporate this teaching into the sunshade of Lii '467 for its explicit purpose of mounting the sunshade would have been obvious to one of ordinary skill in the art. As to the specific dimension of the gripping member, inasmuch as there is nothing to indicate that the recited range is significant or anything more than one of numerous dimensions one having ordinary skill in the art would have found obvious for the purpose of facilitating the operation of the shade, no patentable weight has been attributed thereto.

4. The applicants state that in the Lii reference the retraction mechanism permits partial retraction of the windshield blind but not by a controlled predetermined distance as is set forth in independent claim 1, and further that to cause a partial retraction one would have to slide the control element in one direction and then quickly reverse it back to the neutral position. However, if one were to slide the control element of Lii in one direction and then quickly reverse it back to the neutral position such a movement would be a controlled movement setting forth a predetermined distance.

The applicants argue that there is no suggestion or incentive to combine the teaching of McGuire into the specific application of a vehicle sunshade. This is not convincing for both the references to Lii and to McGuire are from the applicants' field of endeavor, wherein, the applicants are presumed to have full knowledge of the prior art within their respective field of endeavor.

As to the applicants' argument that in the Lii reference the housing leaves most of the circumference of the drum and the sunshade wrapped about the drum uncovered and as such a person would clearly be able to touch a portion of the shade element that is wrapped about the drum member. It should be noted that the housing of Lii is shaped and sized so as to preclude a person from being able to touch that portion of the shade

element which is wrapped about the drum member and protected by the presence of the housing. This reduces the possibility of a person fingers from being pinched.

The applicants argue that the long narrow strip of Park does not have sufficient width to permit a consumer to conveniently disengage the suction cups from the vehicle window and further that it does not disclose or suggest a width that is sufficient to create a lever arm that is within a range of about .4 inch to about 2.5 inch. The particular width of the gripping member is an engineering design choice inasmuch as one having ordinary skill in the art would have readily recognized the selection of a particular width for the purpose of facilitating the movement of the suction cups from the vehicle window.

The applicants state that the Park and Lii references clearly do not disclose or suggest a gripping member and a second mounting means constructed and arranged so as to facilitate disengagement of the second mounting means from the second portion of the vehicle window when the second portion of the vehicle window is attempted to be lowered into the vehicle door. This argument is more specific than the claims for the claims of the instant application are drawn to the sunshade per se and not to the combination of the shade with the vehicle.

With respect to the applicants' argument that there is a fundamental operable difference between the sliding motion disclosed in the Lii reference and the depressing motions set forth in claim 41 in that depressing a control element can be accomplished by using one hand while sliding a control element requires bracing the rest of the apparatus using both hands. This argument appears to be unfounded in that there is nothing to indicate that bracing the apparatus of Lii is necessary for retracting the

shade. Furthermore, there is nothing to preclude one from bracing the apparatus of the instant application during the retracting of the shade.

Applicant's arguments have been fully considered but they are not persuasive.

5. Applicant's amendment further clarifying and defining the scope of the claimed invention necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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DMP
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October 31, 2003